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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/648,589
Filing Date: August 25, 2003
Appellant(s): PURCELL ET AL.

MAILED

OCT 18 2007

Group 3700

Andrew R. Peret
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 8, 2007 appealing from the Office action mailed May 2, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

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(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

NEW GROUND(S) OF REJECTION

Claims 13 and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Peterson (US 5,538,500).

(7) Claims Appendix

A substantially correct copy of appealed claims 7-9, 11-20, 26-28 and 31 appears on pages 19-21 of the Appendix to the appellant's brief. The minor errors are as follows: Claim 26 (on page 20) has been corrected below to coincide with the amendments filed on January 31, 2007.

26. A method of supporting a portion of a body, the method comprising:
attaching one end of an elastic band to skin on the body using an adhesive;
wrapping the elastic band around the portion of the body; and
securing a plurality of fingers that project from an opposing end of the elastic band to an exposed section of the elastic band.

(8) Evidence Relied Upon

Chalek, Matthew J.	US 6,936,018 B2.	August 30, 2005.
Peterson, Donald A.	US 5,538,500.	July 23, 1996.
Daneshvar, Yousef.	US 2003/0149389.	August 7, 2003.

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Hymes, Alan C.	US 6,455,065 B1.	September 24, 2002.
Podell et al.	US 5,620,702.	April 15, 1997.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7-9 and 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Chalek (US 6936018 B2).

Regarding claim 7, Chalek discloses a flexible wrap (10, column 4 line 46) for supporting a portion of a body, the flexible wrap comprising: an elastic band (12, column 4 line 46); and a plurality of fingers (26) extending from an end of said elastic band (see Fig 1), wherein said plurality of fingers are secured to an exposed section of said elastic band when the flexible wrap is attached to the body (column 5 lines 25-26), wherein each of said plurality of fingers is integral with said elastic band (Fig 1, column 5 lines

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18-19). It has been held that the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973).

Regarding claim 8, Chalek discloses the flexible wrap of claim 7 further comprising a plurality of fasteners (26) wherein at least some of the fingers includes at least one fastener for securing said plurality of fingers to said exposed section of said elastic band (column 5 lines 25-26).

Regarding claim 9, Chalek discloses the flexible wrap of claim 8 wherein each of the fingers includes at least one fastener (26) for securing said plurality of fingers to said exposed section of said elastic band (column 5 lines 25-26).

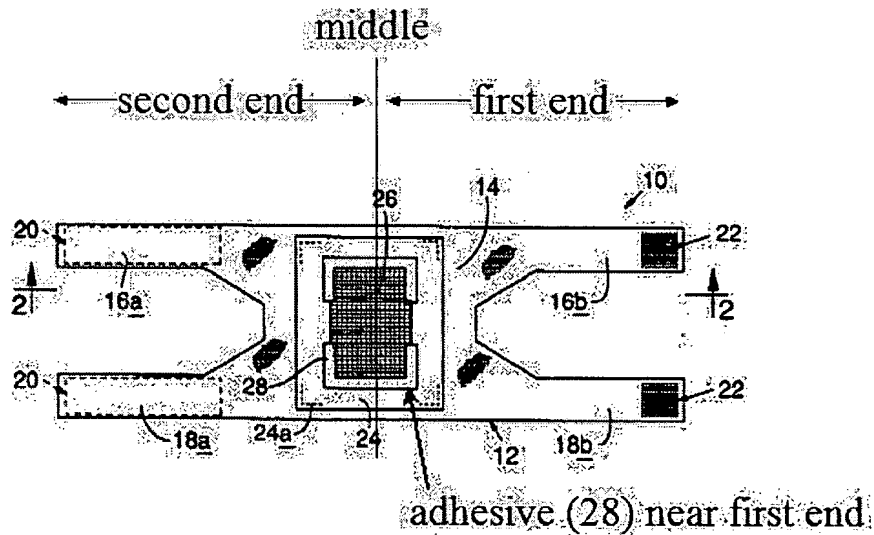
Regarding claim 11, Chalek discloses the flexible wrap of claim 9 wherein said plurality of fingers includes at least one finger that extends from said end of said elastic band along a lateral edge of said elastic band and at least one other finger that extends from said end of said elastic band along an opposing lateral edge of said elastic band (see Fig 1).

Regarding claim 12, Chalek discloses the flexible wrap of claim 11 wherein said plurality of fingers includes at least one finger that extends from a midsection of said end on said elastic band (see Fig 1).

Claims 13, 15-19, 26-29 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Peterson (US 5538500).

Regarding claim 13, Peterson discloses a flexible wrap (10) for supporting a portion of a body, the flexible wrap comprising: an elastic band (14) having a first end and a second end; an adhesive layer (28) mounted on said elastic band near said first end to secure said elastic band to a body (column 5 lines 1-6 and lines 41-43), wherein said adhesive layer is adapted to be detachably mounted to skin on the body; a plurality of fingers extending from said second end of said elastic band (16b and 18b), wherein said plurality of fingers are integral with said elastic band and secured to an exposed section of said elastic band (16a and 18a) when the flexible wrap is attached to the body (see Figs 4 and 5); and a plurality of fasteners, wherein each finger includes at least one fastener for securing said plurality of fingers to said exposed section of said elastic band (20 and 22).

Examiner is interpreting the recitation "a first end" to be any portion or the entire portion to the right of the middle of the band, and "a second end" to be any portion or the entire portion to the left of the middle of the band. Therefore, Peterson does disclose an adhesive layer (28) mounted on said elastic band near the first end. Figure 1 of Peterson (below) has been enhanced to show this interpretation.



Regarding claim 26, the same interpretation of “one end” and “an opposing end” has been applied. Peterson discloses a method of supporting a portion of a body, the method comprising: attaching one end of an elastic band to skin on the body using an adhesive (28, Fig 1); wrapping the elastic band around the portion of the body (column 3 lines 57-60); and securing a plurality of fingers that project from an opposing end of the elastic band (16b and 18b) to an exposed section of the elastic band (16a and 18a).

Regarding claim 27, Peterson discloses the method of claim 26 further comprising repositioning at least one of the plurality of fingers to customize pressure applied by the elastic band (column 3 lines 62-65).

Regarding claim 28, Peterson discloses the method of claim 27 wherein repositioning at least one of the plurality of fingers includes disengaging the at least one of the plurality of fingers from the elastic band and then securing the at least one of the plurality of fingers to another part of the elastic band (column 3 lines 60-65).

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Regarding claim 31, Peterson discloses the method of claim 26 wherein wrapping an elastic band around the portion of the body more than one time but less than two times (see Fig 4).

Claims 15-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Peterson.

Regarding claim 15, Peterson discloses a flexible wrap (10) for supporting a portion of a body, the flexible wrap comprising: an elastic band (14); a pack (24) that includes a midsection; and a fastener extending along said midsection of said pack such that said fastener secures said pack to said elastic band (Fig 1). Examiner has interpreted the term "midsection" to include the entire section that is within the perimeter of the pack. Peterson clearly shows a fastener (24a) extending along the midsection of the pack in Figures 1 and 2.

Alternatively, one might interpret the term "midsection" to only include the sections that are closest to the center of the pack. Using this interpretation, Peterson does not disclose a fastener along the midsection of the pack. However, Peterson does teach that the pack need not be secured to the wrap entirely around its circumference (column 4 lines 15-17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Peterson by placing the adhesive layer so it extends along the midsection of the pack in order to reduce the amount of adhesive needed to secure the pack to the elastic band or to reduce the complexity required during the manufacturing of the invention.

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Regarding claim 16, Peterson teaches the flexible wrap of claim 15, as described above, wherein said fastener is an adhesive (column 4 line 13).

Regarding claim 17, Peterson teaches the flexible wrap of claim 16, as described above, wherein said adhesive is an adhesive layer that extends between opposing edges of said pack on two sides of the pack (column 4 lines 17-18). Peterson does not disclose a single adhesive layer that extends along the midsection of the pack. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Peterson by placing the adhesive layer so it extends along the midsection of the pack in order to reduce the amount of adhesive needed to secure the pack to the elastic band or to reduce the complexity required during the of manufacturing the invention.

Regarding claims 18 and 19, Peterson teaches the flexible wrap of claim 17, as described above, wherein the elastic band includes lateral edges (Fig 1), but does not specifically disclose the flexible wrap wherein the adhesive layer is transverse to said lateral edges when the pack is secured to said elastic band or wherein said adhesive layer extends between said lateral edges. However, Peterson teaches that the pack may be secured only on two sides or the four corners (column 4 lines 17-18). Another obvious option would be to secure the pack by placing an adhesive layer so it extends along the midsection of the pack, as described above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Peterson invention so that said adhesive layer is transverse to said lateral edges and said adhesive layer extends between said lateral edges when said pack is secured to

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said elastic band in order to secure the pack to the elastic band in the best mode when the wrap is attached to the body (Figs 4 and 5) while using an adhesive layer along the midsection of the pack.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson as applied to claim 13 above, and further in view of Daneshvar.

Peterson discloses the flexible wrap of claim 13, as described above, but does not disclose the wrap wherein the elastic band includes a plurality of layers. Daneshvar teaches a flexible wrap with an elastic band with an adhesive layer and a plurality of fasteners to secure the elastic band around the portion of the body, wherein the elastic band includes a plurality of layers (paragraph 0437). It would have been obvious to one

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of ordinary skill in the art at the time the invention was made to have modified Peterson in view of Daneshvar by making the elastic band out of a plurality of layers in order to provide a stronger elastic band.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson as applied to claim 16 above, and further in view of Hymes (PN 6455065 B1) and Podell et al (PN 5620702).

Peterson discloses the flexible wrap of claim 16, as described above, but does not disclose the wrap wherein the adhesive is a hydrogel. Hymes teaches an acne patch (10) attached to the skin with a hydrogel adhesive (14). Podell et al teaches a bandage (10) with a hydrogel adhesive (column 5 lines 2-3). Hydrogel is a standard type of bandage-skin adhesive used in medicine and medical applications. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included hydrogel adhesives in the range of adhesives acceptable for use in the Peterson invention.

(10) Response to Argument

Applicant's argument regarding claims 7-9 and 11-12 is not found persuasive because it has been held that the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973).

Applicant's argument regarding claims 26-28 and 31 is not found persuasive. Applicant argues that Peterson does not disclose "attaching one end of an elastic band to skin on the body using an adhesive." Examiner has taken "one end" to be any portion or the entire portion to the right of the middle of the band, and "an opposing end" to be any portion or the entire portion to the left of the middle of the band (see the Figure above). Therefore, Peterson does disclose the method as claimed.

Upon reviewing the case, Examiner has rejected claim 13 as being anticipated by Peterson. Examiner has taken "a first end" to be any portion or the entire portion to the right of the middle of the band, and "a second end" to be any portion or the entire portion to the left of the middle of the band (see the Figure above). Therefore, Peterson does disclose the flexible wrap as claimed.

Examiner has rejected claims 15-19 as being anticipated by Peterson. The term "midsection" is sufficiently broad to include any area that lies within the perimeter. Therefore, the fastener of Peterson does disclose a fastener extending along the midsection of the pack. Alternatively, Examiner has rejected the claims as being unpatentable over Peterson. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Peterson by placing the adhesive layer so it extends as a strip along the middle of the pack in order to reduce the amount of adhesive needed to secure the pack to the elastic band or to reduce the complexity required during the of manufacturing the invention. One strip of adhesive along the midline of the pack would require less adhesive than putting adhesive around the entire pack. The complexity required during manufacturing would be reduced if one

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strip of adhesive were applied across the middle of the pack because adhesive is only applied in one direction. Examiner maintains that one of ordinary skill would have made these obvious modifications to the wrap of Peterson.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR

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41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Jacqueline Papapietro *JMP*

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Fred Schmidt


FREDERICK A. SCHMIDT
DIRECTOR
TECHNOLOGY CENTER 3700

Conferees:

Linda Dvorak /Linda Dvorak/

SPE, Art Unit 3739

Tom Hughes /Tom Hughes/